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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Edgar Pau

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EXAMINER

THOMASSON, MEAGAN J

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

10/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/965,605	PAU ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Meagan Thomasson	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

The examiner acknowledges the amendments made to claims 1,3,4,14,17 and 20-22. Claims 5 and 23 have been canceled; claims 1-4 and 6-22 are pending in this application.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-13,17,18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher (US 6,776,711 B1) in view of Baerlocher et al. (US 6,569,015 B1); herein referred to as Baerlocher '711 and Baerlocher '015, respectively.**

Regarding claim 1,17,20,21 Baerlocher '711 discloses a gaming machine comprising a display and a game controller arranged to control images displayed on the display, the game controller being arranged to play an underlying game wherein one or more random events are caused to be displayed on the display and, if a predefined winning event occurs, the machine awards a prize (i.e. Baerlocher '711 discloses a slot machine, col. 1-2). Further, Baerlocher '711 discloses upon the occurrence of a predefined triggering event, the player is offered a choice of two or more different prize

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sets, from which the player is allowed to choose only one prize set (col. 3, lines 35-40; a player selects the "Pick" button to choose a prize set). Each prize set contains a plurality of prize outcomes, including non-winning prize outcomes ("bonus terminators"; col. 7, lines 35-42). From the selected prize set a prize is drawn (col. 4, lines 1-8), and wherein each prize sets has the same number of potential outcomes from which prize sets a prize is to be drawn and awarded to the player (Fig. 6, [56a] and [58a]; col. 7, line 55). The prize outcomes of each prize set are independent of any prize awarded in the underlying game on the occurrence of a predefined triggering event (prizes may be an award of base game credits independent of base game winnings; col. 7, lines 24-25), and wherein at least one of the prize sets display at least two different winning outcomes (Fig. 6, [56a] and [58a]), and wherein the total theoretical return to the player is the same regardless of the prize set the player chooses (Col. 8, lines 1-2, "for each level, sets containing roughly the same average values and risk level").

Further, the prize sets of Baerlocher '711 have different volatilities based on a distribution of winning and non-winning outcomes and prize amounts in each of the different prize sets. As shown in Fig. 3, the level 3 prize sets have different volatilities as the first award set shown has prizes ranging from a minimum amount of 10 to a maximum amount of 25, and the second award set shown has prizes ranging from a minimum amount of 12 to a maximum amount of 22. As a result, the first award set is more "volatile" than the second award set because the range of possible prizes is much greater.

*Baerlocher '711 does not specifically disclose that the prize outcomes of each prize set are displayed to the player prior to the player selecting a prize set.* Col. 3, lines 59-63 of Baerlocher '711 disclose that upon player selection of a pick button, one of the award groups is assigned to each pick button. However, in an analogous slot machine bonus round invention, Baerlocher '015 discloses allowing a player to choose a prize set (i.e. the player may choose "Value" or "Multiplier"), wherein the prize sets display the prize outcomes to the player prior to the player selecting a prize set (Fig. 2, [104] wherein "Bonus Scheme Selects and Displays A Value, Multiplier, and Offer", prior to player selection step [106]). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention disclosed by Baerlocher '711 with the teachings of Baerlocher '015 (i.e. a bonus round wherein the prizes of a prize set are displayed to a player prior to a player selection), as the inventions are analogous in that they both disclose a bonus game featuring player-selectable prize sets wherein a prize contained in the selected prize set is randomly chosen and awarded to a player. One would have been motivated to do so in order to provide a player with a greater feeling of control over the bonus outcome that is to be awarded to the player. Further, Baerlocher '711 states that "the game can award the prize in a plurality of ways" (col. 10, line 56), including that "The game can increase player enjoyment and excitement by disclosing the existence of an additional prize or even the value of an additional prize up front. The knowledge of such a potential prize increases excitement and enjoyment as the player selects a pick button and waits to learn the player's fate" (col. 10, line 53 – col. 11, line 4).

Regarding claim 2, Baerlocher '711 discloses one prize set contains one or more prize outcomes which may be identical to prize outcomes in a different prize set, in Fig. 6; wherein both prize sets 56a and 58a contain the prize outcome "5".

Regarding claim 3, Baerlocher '711 does not specifically disclose one prize set contains one or more prize outcomes which are identical to one or more other prize outcomes in that one prize set. However, Baerlocher '711 discloses the ability of the implementor to structure the awards in the set (col. 7, line 45), and that "the values of the awards are for illustration purposes, and that the game can employ any desired values" (col. 7, lines 60-62). Thus, it would have been obvious to one of ordinary skill in the art to include prize outcomes that are identical to prize outcomes in another award set.

Regarding claim 4, Baerlocher '711 discloses one or more of the prize sets contains non-winning prize outcomes (Bonus Terminators, as described above).

Regarding claim 6, Baerlocher '711 discloses the predefined triggering event is an occurrence of a special combination during the underlying game (col. 6, lines 54-65).

Regarding claim 7, Baerlocher '711 discloses the predefined triggering event is triggered at random, as symbol combinations are determined randomly.

Regarding claim 8, Baerlocher '711 discloses the underlying game may "incorporate any game such as slot, poker, or keno" (col. 5, lines 20-21).

Regarding claim 9, Baerlocher '711 discloses that the prizes are presented such that the awards may "rotate within a confined area (e.g. the star)" (col. 9, lines 48-52), as shown in Fig. 6, prior to awarding the player with the designated prize. Thus, it would

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have been obvious to one of ordinary skill in the art at the time of the invention to present the prizes on segments of wheels that can spin or simulate spinning before stopping randomly on a segment which defines the prize outcome won by the player.

Regarding claims 10,11,18 Baerlocher '711 does not specifically disclose presenting the sets of prizes on three dimensional objects or simulations thereof defining faces which the sets of prizes being presented on the faces of those objects are arranged to spin or turn to simulate spinning or turning before stopping to show or indicate a face of the object which defines the prize won by the player. However, Baerlocher '711 does disclose the use of two-dimensional display objects in order to display the prizes of a prize set to a player (stars of Fig. 6). It would have been obvious to one of ordinary skill in the art to present the prizes in three-dimensional objects, (e.g. dice) as this is merely a design choice at the discretion of the implementor, and does not provide any new, novel, or unobvious feature to the invention as it does not provide any new or unobvious outcome to the bonus game.

Regarding claim 12, Baerlocher '711 does not specifically disclose presenting each prize set differently. However, this is again a design choice at the discretion of the inventor and does not provide any new or unobvious outcome to the bonus game. Thus, it would have been obvious to one of ordinary skill in the art to present each prize differently.

Regarding claim 13, Baerlocher '711 does not specifically disclose the sets of prizes are presented on representations of board games with the player choosing which board they wish to play and wherein a random selection indicates the number of

squares around the selected board that the player will move with the square on which the player lands being the square that defines the prize outcome. However, this is again merely a design choice as to the method of presentation for the bonus game, and does not alter the bonus game outcome. Thus, the use of board game embodiments would have been obvious to one of ordinary skill in the art at the time of the invention.

Regarding claim 21, in addition to the invention disclosed above, Baerlocher '711 discloses that none of the prize sets include a losing outcome which results in the loss of any prize awarded in the underlying game or a stake wagered on the underlying game. Instead, the "Bonus Terminators" only end the bonus round, and do not affect previous winnings (col. 7, lines 34-36).

Regarding claims 22 and 23, in addition to the invention described above, Baerlocher '711 discloses that the volatility of at least two of the prize sets differ from each other in that the first 2 levels of prize sets in the bonus game may not contain "Bonus Terminator" symbols, and are thus less volatile than prize sets in subsequent levels of the bonus game (Fig. 8).

**Claims 14-16,19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher (US 6,776,711 B1), Baerlocher et al. (US 6,569,015 B1), and further in view of Baerlocher et al. (US 5,788,573); herein referred to as Baerlocher '711, Baerlocher '015 and Baerlocher '573, respectively.**

Regarding claim 14, Baerlocher '711/'015 discloses the invention as described above (see claims 1 and 9). Baerlocher '711/'015 does not specifically disclose that the

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selected wheel is enlarged relative to any non-selected wheels. However, Baerlocher '711 does disclose enlarging the randomly drawn prize from the selected prize set for display to the player (Fig. 7). In a similar bonus game invention, Baerlocher '573 discloses a bonus game comprising a plurality of wheels, wherein the wheel currently being spun is enlarged relative to any non-spinning wheels (Fig. 4). Thus, it would have been obvious to one of ordinary skill in the art to provide a feature wherein the selected wheel is enlarged relative to any non-selected wheels. One would be motivated to do so in order to visually distinguish the player-selected wheel from the non-selected wheel, just as Baerlocher '711 discloses enlarging prizes to distinguish the drawn prize from the non-drawn prizes.

Regarding claim 15, Baerlocher '711 discloses one prize set contains one or more prize outcomes which may be identical to prize outcomes in a different prize set, in Fig. 6; wherein both prize sets 56a and 58a contain the prize outcome "5".

Regarding claim 16, Baerlocher '711 does not specifically disclose one prize set contains one or more prize outcomes which are identical to one or more other prize outcomes in that one prize set. However, Baerlocher '711 discloses the ability of the implementor to structure the awards in the set (col. 7, line 45), and that "the values of the awards are for illustration purposes, and that the game can employ any desired values" (col. 7, lines 60-62). Thus, it would have been obvious to one of ordinary skill in the art to include prize outcomes that are identical to prize outcomes in another award set.

Regarding claim 19, Baerlocher '711/'015 does not specifically disclose any non-selected wheels disappear from the display when the selected wheel is enlarged. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include this feature for arguments similar to that of enlarging the selected wheel, in that causing all non-selected wheels to disappear from the screen visually distinguishes the selected element to the player. In a similar manner, Baerlocher '711 discloses causing all non-selected prizes to disappear from the screen (Fig. 7). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to cause the non-selected wheel to disappear instead of the non-selected prizes, as is currently disclosed by Baerlocher '711.

### ***Response to Arguments***

Applicant's arguments filed August 9, 2007 have been fully considered but they are not persuasive.

Specifically, applicant argues that Baerlocher '711 in combination with Baerlocher '015 does not disclose that the prize outcomes of each prize set are displayed to the player prior to the player selecting a prize set. As detailed in the previous and above rejections, Baerlocher '015 discloses this feature such that a player is presented with two prize sets, a Value prize set and a Multiplier prize set as shown in Fig. 1, that display all possible outcomes of both prize sets prior to a player making a selection of a prize set. Upon selecting the prize set of their choice, a single outcome is randomly selected from said selected prize set. This does, in fact, allow a player to

“debate the relative risk and reward in a particular prize set and select a particular prize set for pursuit”, as argued on P. 2 of applicant’s remarks as being an object of the instant application, as a player may consider each possible outcome displayed on the prize sets and evaluate their odds of obtaining a higher outcome should they select that prize set. For instance, if the player’s current prize offer comprises an outcome of 4 from the Multiplier prize set, the player would not choose the Multiplier prize set for a new offer as 4 is the highest possible attainable value in said Multiplier prize set (Fig. 1). Thus, the player is able to make a personal judgment of risk versus reward and the game activity is governed by that choice, as in the example given the risk of choosing the Multiplier prize set for outcome generation is greater than the possible rewards if the offer already contains 4 as the current Multiplier value.

Additionally, applicant argues that Baerlocher ‘711 in combination with Baerlocher ‘015 does not teach prize sets having different volatilities based on a distribution of winning and non-winning outcomes and prize amounts in each of the different prize sets while the total theoretical return to the player is the same regardless of the prize set the player chooses. This is not found to be persuasive as col. 8, lines 1-2 of Baerlocher ‘711 disclose that “for each level, sets containing roughly the same average values and risk level”. That is, each prize set has roughly the same theoretical outcome. Further, the prize sets of Baerlocher ‘711 have different volatilities based on a distribution of winning and non-winning outcomes and prize amounts in each of the different prize sets. As shown in Fig. 3, the level 3 prize sets have different volatilities as the first award set shown has prizes ranging from a minimum amount of 10 to a

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maximum amount of 25, and the second award set shown has prizes ranging from a minimum amount of 12 to a maximum amount of 22. As a result, the first award set is more "volatile" than the second award set because the range of possible prizes is much greater.

In response to applicant's arguments that Baerlocher '711 in combination with Baerlocher '051 does not disclose presenting the sets of prizes on three dimensional objects or simulations thereof defining faces which the sets of prizes being presented on the faces of those object are arranged to spin or turn to simulate spinning or turning before stopping to show or indicate a face of the object which defines the prize won by the player and that doing so is not a design choice that would have been obvious to one of ordinary skill in the art at the time of the invention, this is not found to be persuasive. Baerlocher '711 does disclose the use of two-dimensional display objects in order to display the prizes of a prize set to a player (stars of Fig. 6) and the examiner maintains that it would have been obvious to one of ordinary skill in the art to present the prizes in three-dimensional objects, (e.g. dice) as this is merely a design choice at the discretion of the implementor, and does not provide any new, novel, or unobvious feature to the invention as it does not provide any new or unobvious outcome to the bonus game, as evidenced by Carlson et al. (US 6,802,774 B1). Carlson discloses a slot machine type gaming device wherein a secondary game may be presented to a player in the form of a rolled pair of dice or a wheel featuring a plurality of numbers (Fig. 7 and 8, col. 2, lines 56-57). Thus, the examiner maintains that presenting a gaming outcome to a player by

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means of a three-dimensional object as claimed is not new, novel, or unobvious to one of ordinary skill in the art at the time of the invention.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pertinent prior art includes Carlson et al. (US 6,802,774 B1), used as evidence to show obviousness of presenting gaming outcomes to a player utilizing a three-dimensional object such as a pair of dice.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

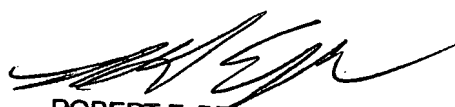
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Meagan Thomasson  
October 11, 2007

  
ROBERT E. PEZZUTO  
SUPERVISORY PRIMARY EXAMINER